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1038.1001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Ravi I. SHARMA
Serial No.	:	10/528,164
Filed	:	March 14, 2005
For	:	INVERTED KEYBOARD INSTRUMENT AND METHOD OF PLAYING THE SAME
Group Art Unit	:	Not yet assigned
Examiner	:	Not yet assigned
Confirmation No.	:	6495

APPLICANT'S REPLY TO DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT AND REQUEST FOR RECONSIDERATION

Office Of PCT Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant submits this Reply To Decision On Petition in accordance with 37 C.F.R. § 1.181. For reasons to follow, Applicant respectfully requests reconsideration of the Attorney Advisor's Decision refusing to withdraw the holding of Abandonment in this Application.

I. THE USPTO'S POSTING ON PRIVATE PAIR THAT THE APPLICATION WAS "UNDERGOING PREEXAMINATION PROCESSING" WAS CLEARLY MISLEADING

According to the official position taken by the Attorney Advisor on page 1, paragraph 3 of his Decision On Petition, the present Application was not being processed

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on April 26, 2007
Name Grant E. Pollack
Signature

and COULD NOT[1] be processed, during the ten (10) month period following Applicant's early submission of the Application papers, because "the application file include[d] no record of payment" of the basic national fee and because Applicant's submission "did not include an express request to begin national examination procedures".

Yet, PRIVATE PAIR explicitly indicated to Applicant, throughout the period in question, that the Application was, indeed, "undergoing preexamination processing". This fact was documented by Applicant in his Petition To Withdraw Holding Of Abandonment. See Exhibit G of Applicant's Petition To Withdraw Holding Of Abandonment.

Such indication by the USPTO on PRIVATE PAIR, we respectfully submit, if untrue, was clearly misleading to Applicant.

As also demonstrated in Exhibit G, no "Image File Wrapper" on-screen review button had been activated for this Application on PRIVATE PAIR, such making it impossible for Applicant to view the official record of the Application. Accordingly, Applicant, we submit, was at the mercy of what information was (and was not) provided orally by the PCT Help Desk.

Applicant then documents, in the Petition, the numerous telephone status inquiries that were made to, and telephone conferences that were conducted with, the PCT Help Desk over the course of the ten (10) months that followed Applicant's early submission.

While the Attorney Advisor characterizes what Applicant's Counsel was repeatedly told, pursuant to these inquires, as mere "confusion resulting from miscommunication between the Applicant and the PCT Help Desk" under 37 C.F.R. § 1.2, not only is this a mischaracterization, but it also demonstrates an improper application of § 1.2.

We respectfully submit, this is not solely a matter of oral communications, but of express written communications from the USPTO, i.e., posted on PRIVATE PAIR, as well. It is also not a matter of a single oral communication from which there could have been "confusion resulting from miscommunication", but rather numerous telephone communications with the PCT Help Desk. What Counsel was repeatedly told during those communications was consistent with what was plainly, though incorrectly according to the Advisor, indicated on PRIVATE PAIR.

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[1] On page 2 of the Decision, in paragraph 4, the Attorney Advisor states that "...regardless of when the national stage papers were filed, the USPTO *could not commence* national stage processing of the present application until thirty months from the priority date, i.e., 25 January 2006". (emphasis added).

Moreover, contrary to what is specifically required for § 1.2 to apply,[2] no assertion was made by Applicant in the Petition that any "oral promise" was made by a Patent Office Representative. We also did not contend that there was any "stipulation", agreement or deal reached with the Patent Office by telephone, as otherwise required by § 1.2, nor did we indicate that there was an "understanding" between Applicant and the USPTO pursuant to prosecution of the captioned Application, under § 1.2.

The present case concerns a clear pattern of misinformation - such misinformation being provided repeatedly and consistently to Applicant, not just by Attendants at the PCT Help Desk but on PRIVATE PAIR as well. And this misinformation mislead Applicant to take no action.

We submit, 37 C.F.R. § 1.2 simply does not apply, nor can it be used to shield the USPTO from responsibility for explicitly and repeatedly misinforming an Applicant.

II. THE ATTORNEY ADVISOR'S ASSERTION THAT APPLICANT ERR'D IN NOT MAKING AN EXPRESS REQUEST TO BEGIN NATIONAL EXAMINATION IS CLEARLY ERRONEOUS

The statutory basis for making an Express Request is 35 U.S.C. § 371(f). This section states, "[a]t the express request of the applicant, the national stage of ***processing may be commenced at any time at which the application is in order*** for such purpose and the applicable requirements of subsection (c) of this section have been complied with".[3] (emphasis added). In other words, to proceed according to an Express Request

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[2] 37 C.F.R. § 1.2 provides, "All business with the Patent and Trademark Office ***should*** be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to ***any alleged oral promise, stipulation, or understanding*** in relation to which there is disagreement or doubt". (emphasis added).

[3] The statutory basis for commencement of the National Stage of an International Application is 35 U.S.C. § 371(c). Under § 371(c), "[t]he applicant ***shall file*** in the Patent and Trademark Office - (emphasis added)

> (1) the national fee provided in section 41(a) of this title;
>
> (2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;
>
> (3) amendments, if any, to the claims in the international application, made under article 19 of the treaty, unless such amendments have been communicated to the Patent and Trademark Office by the International Bureau, and a translation into the English language if such amendments were made in another language;
>
> (4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants; [and]

under § 371(f), the Applicant must submit each of the items listed (1) - (5) under § 371(c). (See Footnote No. 3). If an Applicant omits to provide any of these items, then he or she simply can not proceed under § 371(f).

Hence, in order to make an Express Request for early entry to the National Stage, an Applicant must have included the filing fee, a signed Declaration and a copy of the International Application. Since a Declaration was clearly not filed concurrently with the Application, it would have been improper for Applicant to make an Express Request under 37 C.F.R. § 371(f).

The net result of the position taken by the Advisor, however, is that, for Applicant to have been eligible to receive Form PCT/DO/EO/912 (hereinafter "Form 912") from the USPTO, Applicant must have made an improper Express Request under § 371(f). Put another way, Applicant, as suggested by the Advisor, must have falsely stated that he was proceeding under § 371(f), even though he was not providing all of the items necessary under 37 C.F.R. §§ 371(c) and (f) - in the present case - a signed Declaration.

The Attorney Advisor's position in this regard, we respectfully state, is clearly erroneous.

III. THE ATTORNEY ADVISOR'S ASSERTION THAT FORM PCT/DO/EO/912 APPLIES ONLY WHEN AN EXPRESS REQUEST HAS BEEN MADE IS ALSO ERRONEOUS

We respectfully submit that there is no support in the USPTO Rules for the Advisor's suggestion in his Decision On Petition, nor for his contention during telephone discussions with Applicant's Counsel that followed the Decision, that a Notice Of Insufficient Basic National Fee Required (Form 912) is used only when an Express Request has been made by Applicant.

If the Attorney Advisor's assertion was true, we submit, then Form 912 would request EACH of the items expressly required for an Express Request filing under § 371(f) and thus § 371(c), namely, the Filing Fee, a signed Declaration, a copy of the International Application, a Translation, etc., as appropropriate. Form 912, however, does not.[4] Rather, what is requested by Form 912 concerns the Filing Fee and copy of

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(5) a translation into the English language of any annexes to the international preliminary examination report, if such annexes were made in another language.

[4] Form 912 is entitled "Notice Of Insufficient Basic National Fee Required And/Or Missing Copy Of International Application Under 35 U.S.C. 371 and 37 CFR 1.495". The Form expressly states, in pertinent part: "The current record of this application indicates that the basic national fee (37 CFR

the Application ONLY, and this falls short of what is statutorily required to process an Application under § 371(f). Again, absent all items required under § 371(c), Applicant simply could not proceed under § 371(f).

Moreover, that Form 912 requires only the Filing Fee and the Application copy confirms that this Form is to be mailed prior to expiration of (30) thirty months from the priority date, whether Applicant has made an Express Request or not.

We respectfully believe that the reason why Form 912 was not mailed to Applicant is not because the USPTO was not obliged to do so, but rather because the USPTO, due to its tremendous backlog in processing Applications, "didn't get to" this Application until several months after the final deadline for National Stage entry, as Applicant's Counsel was later told by the PCT Help Desk. (See Petition To Withdraw Holding Of Abandonment, page 2, paragraph 5).

If this was not the case, then the USPTO erroneously mails Form 912 to Applicants and processes Applications pursuant to Express Requests pursuant to § 371(f), even though Applicants have not provided all of the items required under § 371(c).

IV. ONCE THE USPTO NOTIFIED APPLICANT ON PRIVATE PAIR THAT THE APPLICATION WAS "UNDERGOING PREEXAMINATION PROCESSING", IT WAS OBLIGED TO NOTIFY APPLICANT THAT THE FILING FEE HAD NOT BEEN RECEIVED

We respectfully submit that it is irrelevant whether the present Application was "actually" undergoing preexamination processing or not. PRIVATE PAIR explicitly provided notice to Applicant that his Application was being processed, an indication that was false, according to the Attorney Adviser, and therefore misleading. Applicant reasonably relied on this misinformation which, in turn, mislead Applicant to take no further action other than to repeatedly inquire with the PCT Help Desk by telephone, according to customary practice, as to why no filing confirmation had been received.

Having notified Applicant via PRIVATE PAIR that the Application was "undergoing preexamination processing" and, thereby, treating the Application as one

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1.492(a)) required is [ ]. The basic national fee to enter the national stage in the United States of America under 35 U.S.C. 371 must be paid by 30 months from the priority date (37 CFR 1.495(b)(2)). If the proper basic national fee is not paid within 30 months from the priority date, the international application will become ABANDONED as to the United States of America, and will not be accepted for national examination."

that was "undergoing preexamination processing", we respectfully submit, the USPTO was obliged to transmit to him Form 912 - the Notice Of Insufficient Basic National Fee Required - or otherwise notify Applicant as to any issue regarding non-receipt of the Filing Fee.

V. CONCLUSION

Applicant relied not only on the oral representations made by the USPTO, but also on the clear indications in the record, namely, on PRIVATE PAIR, that the Application was being processed. Whether what underlies it all is an internal administration issue at the USPTO or merely a matter of an overwhelming workload and backlog in processing Applications there, it is not, we respectfully submit, a matter for which Applicant and his Counsel should pay the price.

In view of the clear pattern of misinformation to Applicant, both written and oral, regarding the actual status of this Application, we respectfully request that the USPTO withdraw its holding of abandonment and that this Application be reinstated, for prosecution on the merits, without further delay.

Regarding the Attorney Advisor's assertion that Applicant did not include payment of the $750.00 small entity petition fee for Revival Of The International Application Under 37 C.F.R. § 1.137(b), we respectfully disagree. The Credit Card Payment Form submitted with the Application, a copy of which was provided with Applicant's Petition To Withdraw Holding Of Abandonment, provides authorization not only for payment of the filing fee for this Application, but also for payment of "any additional fees required". While Applicant considers it duplicative, an entirely new Credit

Card Payment Form again authorizing payment of the Application Filing Fee and "any additional fees required".

Respectfully submitted,

Dated: April 26, 2007

Grant E. Pollack, Esq.
Registration No. 34,097
POLLACK, P.C.
The Chrysler Building
132 East 43rd Street, Suite 760
New York, New York 10017
Telephone: (646) 265-1468
Facsimile: (646) 253-1276
E-mail: gpollack@pollackpc.com

Attorney for Applicant

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office, (571) 273-0459,
on April 26, 2007
Name Grant E. Pollack

Signature